

Response

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Serial No.: 09/934,031

Confirmation No.: 7794

Filed: 20 August 2001

For: REMOVABLE RETROREFLECTIVE MATERIAL

Remarks

The Office Action mailed 14 March 2006 has been received and reviewed. No claims having been amended, added, or canceled herein, the pending claims are claims 15-22, 38-42, and 44-59. Claims 15-22 and 38-41 having been withdrawn from consideration by the Examiner as being directed to non-elected groups, the claims currently under consideration are claims 42 and 44-59.

Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection under 35 U.S.C. §103(a)

The Examiner rejected claims 44-47 and 59 under 35 U.S.C. §103(a) as being unpatentable over Seber (U.S. Patent No. 4,745,916) in view of Harper et al. (U.S. Patent No. 4,102,562). Applicant respectfully traverses this rejection.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2143. Applicant respectfully submits that the cited documents do not teach or suggest all of the language recited in the present claims.

Specifically, the Examiner acknowledged that "Seber fails to disclose a layer of retroreflective beads that are partially embedded in the non-adhesive side of the single layer backing, wherein the layer of retroreflective beads is substantially held in place in the non-adhesive side of the single layer backing without the use of an additional adhesive or resin" (pages 2-3 of the Office Action mailed 14 March 2006). Further, Applicant wishes to clarify that Seber fails to provide any disclosure or suggestion of retroreflective articles, retroreflective beads, and/or articles having retroreflective beads. In brief, the Examiner appears to be relying

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on Seber for the bare disclosure of a "a thin non-woven, random-spun synthetic fiber textile material capable of blocking ultra-violet radiation" (abstract) as a single layer backing.

The Examiner then asserted that "Harper et al. teach a *backing* . . . comprising a *support layer* . . . and a *heat softenable layer* that acts as a non-adhesive side and a layer of retroreflective beads that are partially embedded in the non-adhesive side of the *single layer backing* to about 30% of the diameters . . . , wherein the layer of retroreflective beads is substantially held in place (*sic*) in the non-adhesive side of the *single layer backing* without the use of an additional adhesive or resin" (page 3 of the Office Action mailed 14 March 2006; emphasis added). Applicant earnestly disagrees with the Examiner's assertion and characterization of the teachings of Harper et al.

First, Applicant was unable to locate any disclosure or suggestion by Harper et al. of a *single layer backing* as asserted by the Examiner. As discussed herein above, Harper et al. clearly state that the backing includes a *support layer* and a *heat softenable layer*, i.e., at least a two layer backing. Thus, Harper et al. cannot be relied upon for the disclosure or suggestion of a *single layer backing* as alleged by the Examiner.

Next, even if the support layer disclosed by Harper et al. arguably were to be considered as a single layer backing, then the use of the heat softenable layer to hold the retroreflective beads in place would have to be considered as the use of an additional adhesive or resin. Thus, Harper et al. also cannot be relied upon for the disclosure or suggestion of a layer of retroreflective beads substantially held in place in the non-adhesive side of a single layer backing *without the use of an additional adhesive or resin*.

Further, Applicants respectfully submit that the motivation for combining Seber, which relates to "[s]un blocking and glare reflective and absorptive tapes and patches for applications to skin areas of human individuals" (abstract), with Harper et al., which relates to a "[t]ransfer sheet material for forming retroreflective graphic images on a substrate" (claim 1) cannot be found in the documents themselves or in the knowledge generally available to one of ordinary skill in the

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art. For example, Applicant respectfully submits that one of skill in the art would have no motivation to modify Seber's tapes and patches for protecting sensitive skin areas and the eyes, to make a transfer sheet material for forming retroreflective graphic images on a substrate. Moreover, one of skill in the art would not arrive at the presently claimed invention by combining Seber and Harper et al., for at least the reasons discussed herein above. For example, neither Seber nor Harper et al. disclose or suggest a layer of retroreflective beads substantially held in place in the non-adhesive side of a single layer backing without the use of an additional adhesive or resin.

Finally, the Examiner asserted with regard to the language "medical tape" in claim 44, that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim" (page 3 of the Office Action mailed 14 March 2006). Applicant respectfully disagrees. Applicant respectfully submits that it would be clear to one of skill in the art, when read in view of the specification, that the term "medical tape" is not merely an intended use, but denotes requirements, for example, that the article be safe for application to human skin (e.g., page 5, lines 19-20; page 6, lines 11-12; and page 12, lines 12-14). Typically, medical tapes include a medical grade adhesive capable of being comfortably adhered to human skin, yet easily removed (e.g., page 2, lines 13-15). Further, medical tapes can also include a medical non-woven backing (e.g., page 5, lines 17-20). Moreover, Applicant respectfully notes that neither Seber nor Harper et al. specifically disclose a medical tape.

For at least these reasons, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of unpatentability for claims 44-47 and 59 being obvious over Sebers in view of Harper et al.

The Examiner rejected claims 42 and 48-58 under 35 U.S.C. §103(a) as being unpatentable over May (U.S. Patent No. 4,648,689) in view of Harper et al. (U.S. Patent No. 4,102,562). Applicant respectfully traverses this rejection.

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"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2143. Applicant respectfully submits that the cited documents do not teach or suggest all of the language recited in the present claims.

May discloses a pavement marking tape that includes an elastomeric body 2 having an adhesive layer 3 attached to the base of the body 2, and reflecting material 4 attached to the top surface 5 of the body 2 (e.g., column 3, lines 33-40). May further teaches that the reflecting material 4 is preferably a thin retroreflective sheet including a polymeric support sheet in which a monolayer of transparent microspheres or beads are embedded (e.g., column 3, lines 44-47). The reflector support sheet has a layer of adhesive on the back by which it is adhered to the body 2 (e.g., column 3, lines 49-52). In other words, May teaches that the microspheres are embedded into a polymeric support sheet that is then adhered to the body 2.

The Examiner acknowledged that "May fails to disclose a layer of retroreflective beads that are partially embedded in the non-adhesive side of the single layer backing, wherein the layer of retroreflective beads is substantially held in place in the non-adhesive side of the single layer backing without the use of additional adhesive of resin" (pages 4-5 of the Office Action mailed 14 March 2006). Further, Applicant wishes to clarify that May fails to provide any disclosure or suggestion of a foam backing having retroreflective beads partially embedded therein (e.g., independent claims 42, 48, and 58), or a single layer backing having retroreflective beads partially embedded therein (e.g., independent claim 55).

The Examiner then asserted that "Harper et al. teach a *backing* . . . comprising a *support layer* . . . and a *heat softenable layer* that acts as a non-adhesive side and a layer of retroreflective beads that are partially embedded in the non-adhesive side of the *single layer*

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backing to about 30% of the diameters . . . , wherein the layer of retroreflective beads is substantially held in place (*sic*) in the non-adhesive side of the *single layer backing* without the use of an additional adhesive or resin" (page 5 of the Office Action mailed 14 March 2006; emphasis added). Applicant earnestly disagrees with the Examiner's assertion and characterization of the teachings of Harper et al.

First, Applicant was unable to locate any disclosure or suggestion by Harper et al. of a *single layer backing* as asserted by the Examiner. As discussed herein above, Harper et al. clearly state that the backing includes a *support layer* and a *heat softenable layer*, i.e., at least a two layer backing. Thus, Harper et al. cannot be relied upon for the disclosure or suggestion of a *single layer backing* as alleged by the Examiner.

Next, even if the support layer disclosed by Harper et al. arguably were to be considered as a single layer backing, then the use of the heat softenable layer to hold the retroreflective beads in place would have to be considered as the use of an additional adhesive or resin. Thus, Harper et al. also cannot be relied upon for the disclosure or suggestion of a layer of retroreflective beads substantially held in place in the non-adhesive side of a single layer backing *without the use of an additional adhesive or resin*.

Further, Applicants respectfully submit that the motivation for combining May, which "pertains to pavement markers used in delineating traffic lanes on highways" (column 1, lines 8-9), with Harper et al., which relates to a "[t]ransfer sheet material for forming retroreflective graphic images on a substrate" (claim 1) cannot be found in the documents themselves or in the knowledge generally available to one of ordinary skill in the art. For example, Applicant respectfully submits that one of skill in the art would have no motivation to modify May's pavement markers used in delineating traffic lanes on highways, to make a transfer sheet material for forming retroreflective graphic images on a substrate. Moreover, one of skill in the art would not arrive at the presently claimed invention by combining May and Harper et al., for at least the reasons discussed herein above. For example, neither May nor Harper et al. disclose or suggest a

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foam backing having retroreflective beads partially embedded therein (e.g., independent claims 42, 48, and 58), or a single layer backing having retroreflective beads partially embedded therein (e.g., independent claim 55).

Finally, the Examiner asserted with regard to the language "medical tape" in claim 43, that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim" (page 5 of the Office Action mailed 14 March 2006). Applicant respectfully submits that the intent of the Examiner's assertion is unclear, because claim 43 has been canceled. In the event that the present rejection is maintained, clarification of this assertion is respectfully requested in the next Official Communication. However, to the extent that the Examiner intended to refer to claim 42, Applicant respectfully disagrees. Applicant respectfully submits that it would be clear to one of skill in the art, when read in view of the specification, that the term "medical tape" is not merely an intended use, but denotes requirements, for example, that the article be safe for application to human skin (e.g., page 5, lines 19-20; page 6, lines 11-12; and page 12, lines 12-14). Typically, medical tapes include a medical grade adhesive capable of being comfortably adhered to human skin, yet easily removed (e.g., page 2, lines 13-15). Further, medical tapes can also include a medical foam backing (e.g., page 5, lines 17-20; and page 6, lines 11-12). Moreover, Applicant respectfully notes that neither May nor Harper et al. disclose or suggest a medical tape.

For at least these reasons, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of unpatentability for claims 42 and 48-58 being obvious over May in view of Harper et al.

In view of the remarks presented herein above, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

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Information Disclosure Statement

Applicant submitted an Information Disclosure Statement on 18 January 2006, but has not received an initialed copy of the 1449 form indicating that the Examiner has considered the document cited therein. For the Examiner's convenience, a copy of the 1449 form submitted with the Information Disclosure Statement on 18 January 2006 is attached herewith as EXHIBIT A. Consideration of the document listed on the attached 1449 form(s) is respectfully requested. Pursuant to the provisions of M.P.E.P. §609, Applicant further requests that a copy of the 1449 form(s), marked as being considered and initialed by the Examiner, be returned with the next Official Communication.

Request for Rejoinder

Withdrawn claims 15-18 are drawn to a method of making, for example, an article according to claim 44. Withdrawn claims 19-22 are drawn to a method of making, for example, an article according to claim 42. Withdrawn claims 38-39, 40, and 41 are drawn to methods of using, for example, articles according to claims 42, 44, and 48, respectively. Upon an indication of any of article claims 42, 44, and/or 48 being allowable, Applicant respectfully requests that the corresponding method claims also be examined and passed on to allowance pursuant to M.P.E.P. §821.04. *See, for example, In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996).

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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June 14, 2006

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of June, 2006, at 9:31 a.m. (Central Time).

By: Name: Rachel Gagliardi-Gaban